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EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/887,430

Applicant(s)

HWANG, WENG JEN

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 3/8/05.
2. Claims 25 – 43 are pending in the case. Claims 25 and 38 are independent.
3. The objection to the claim has been withdrawn as necessitated by amendment.
4. The rejection of claims 2 and 8 under 35 U.S.C. 112, second paragraph as being indefinite has been withdrawn as necessitated by amendment.
5. The rejection of claims 1 – 24 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) and further in view of Sastry et al. (US 6687877 B1).
8. **Regarding independent claim 25**, Eintracht et al. teach that *the notes information are transmitted between client and server applications via TCP/IP protocols over communications means such as a LAN, WAN or the Internet. The invention may be adapted to operate over an Intranet, e.g., LAN, or Extranet, e.g., WAN or the Internet* (Column 2, lines 29 – 33) and that *a synchronization button is provided which, when pressed by the user, transmits the annotations generated by the user from the client to the server using a particular protocol. In response, the server transmits back an*

acknowledgement along with any new notes that other clients may have posted since the last synchronization was performed. A user may annotate many documents at the same time by opening several web browser windows. In addition, other clients can annotate either the same document or other documents at the same or a later time. In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. As a result, the present invention has the advantage of permitting multiple clients to annotate a document that resides on a central web server in an asynchronous fashion (Column 2, lines 41 – 58) and Sastry et al. teach that the recorded annotation sessions can then be played back at a later time, so that the multimedia actions are synchronized with the recorded voice, video, and hyperlink traversals. Moreover, the multimedia actions are displayed during playback in the same sequence as they were recorded (Column 5, lines 53 – 58), compare with, compare with a) transmitting a file operation object, an asynchronous object, a medium play object, and a note record object of the web page to a reader utilizing a server, the reader and the server being connected to the internet; c) displaying the web page in a browser of the reader; and d) creating a note record file in the reader by selecting note record contents of the web page that have been transmitted to the reader and saving the note record file in the note record folder utilizing the note record object. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Eintracht et al. with that of

Sastry et al. because such a combination would allow the users of Eintracht et al. the benefit of a *method for operating a call center includes enabling annotation capabilities and includes the steps of recording a particular sequence of multimedia actions on a first document and transmitting the sequence of multimedia actions to a second terminal as a part of either a callback request or a response to a callback request* (Column 2, lines 20 – 25). Neither Eintracht et al. nor Sastry et al. explicitly teach **b) establishing a note record folder, a picture folder, and a medium folder on the reader utilizing the file operation object**. However, it was notoriously well known to one of ordinary skill in the art at the time of the invention how to create folders for particular document types, e.g. My Pictures folder in Windows 2000.

9. **Regarding dependent claim 26**, Eintracht et al. teach that *in accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each. As a result, the present invention has the advantage of permitting multiple clients to annotate a document that resides on a central web server in an asynchronous fashion* (Column 2, lines 41 – 58) and Sastry et al. teach that *the agent utilizes the annotation plug-in software 72 of the agent terminal 50 to annotate the received web documents. The annotation is preferably a dynamic annotation in which agent actions (such as movement of a pointer icon, traversal of hyperlinks between web pages, manipulation of graphic objects, text objects, image objects, or video objects) are coordinated with recording the agent's voice. The customer can play back the*

annotation session, so that the customer is able to listen and view the response to the callback request much as though the response were a live presentation. Alternatively, the callback request can be in the form of a static annotation (Column 7, lines 21 – 32), compare with a) includes asynchronously transmitting at least one picture and at least one medium object of the web page to the reader utilizing the asynchronous object. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Eintracht et al. with that of Sastry et al. because such a combination would allow the users of Eintracht et al. the benefit of *a method for operating a call center includes enabling annotation capabilities and includes the steps of recording a particular sequence of multimedia actions on a first document and transmitting the sequence of multimedia actions to a second terminal as a part of either a callback request or a response to a callback request (Column 2, lines 20 – 25).* Neither Eintracht et al. nor Sastry et al. explicitly teach **saving the at least one picture in the picture folder, and saving the at least one medium object in the medium folder.** However, it was notoriously well known to one of ordinary skill in the art at the time of the invention how to save document types in particular folders, e.g. My Pictures folder in Windows 2000.

10. **Regarding dependent claim 27,** Sastry et al. teach that *the recorded annotation sessions can then be played back at a later time, so that the multimedia actions are synchronized with the recorded voice, video, and hyperlink traversals. Moreover, the multimedia actions are displayed during playback in the same sequence as they were recorded (Column 5, lines 53 – 58), compare with c) includes playing each of the at*

least one medium object at a predetermined time utilizing the medium play object.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Eintracht et al. with that of Sastry et al. because such a combination would allow the users of Eintracht et al. the benefit of *a method for operating a call center includes enabling annotation capabilities and includes the steps of recording a particular sequence of multimedia actions on a first document and transmitting the sequence of multimedia actions to a second terminal as a part of either a callback request or a response to a callback request* (Column 2, lines 20 – 25).

11. **Regarding dependent claim 32**, Eintracht et al. teach that *upon receipt of the notes buffer, the client updates its locally stored Notes Database (step 134) and then displays the contents of the notes buffer in a window within the web browser (step 136). If the user has selected to view the annotations overlying the document, i.e., the image, then the client displays the notes similarly to that shown in FIG. 1B. The user then can process one or more notes, i.e., create new notes, edit existing ones and/or delete one or more notes (step 138)* (Column 14, lines 14 – 22), compare with **b) includes producing and deleting predetermined files on the reader utilizing the file operation object.**

12. **Regarding dependent claim 33**, Eintracht et al. teach that *FIG. 2 is an illustration of an example annotation* (Column 4, line 62), compare with **d) the note record contents are selected from a group consisting of a letter, a picture object, a voice object, a medium object, and a hyperlink object.**

13. **Regarding dependent claim 34**, Eintracht et al. teach that *an action field 214 represents the action to be taken on the note. The following values are valid actions. 0 No action 1 Add a note 2 Modify a note 3 Delete a note 4 Add a comment 5 Update status* (Column 17, lines 18 – 28), compare with **d) includes creating the note record file with a single-action.**

14. **Regarding dependent claim 35**, Eintracht et al. teach that *the invention can be implemented as software, a portion of which executes on the server side and a portion that executes on the client side. The server side may comprise a plurality of software applications running in parallel that in combination provide the server functionality of the invention. A web server application on the server side functions to capture special requests from one or more client applications for creating, storing, editing and retrieving, annotations related to specific documents located in the server. A notes server functions to log all annotation activities along with information about the corresponding clients that create, edit and retrieve them* (Column 2, lines 16 – 27), compare with **d) includes transmitting the note record file from the reader to the server, and note recording the note record contents of the note record file on the server.**

15. **Regarding dependent claim 36**, Eintracht et al. teach that *if the number of notes is not equal to zero, the client checks the state of the viewing condition flag in the web browser Note Plug-In application. This variable may have the following values; show document only (corresponding to FIG. 1A), show document in addition to notes (corresponding to FIG. 1B), show document and notes in one web browser frame and a list of notes in another web browser frame (corresponding to FIG. 1C)* (Column 14, lines

27 – 33), compare with **d) includes transmitting a program code of the note record contents from the reader to the server.**

16. **Regarding dependent claim 37**, Eintracht et al. teach that *the client issues a request to retrieve the notes associated with the image, if there are any, from the server (step 124). The URL that is supplied to the server to retrieve the notes is the same URL that corresponds to the underlying document (image) but having a suffix of* ``.backslash.notes`` *appended to it. Upon receiving the appended URL, the server searches the Notes Database 60 (FIG. 3) for the specified document using the URL as the key for searching (step 126). Once found, the server filters the notes so as to supply only those notes that the requesting client has permission to view (step 128). The server subsequently serializes the notes after filtering and stores them in a response buffer (step 130). The notes buffer is then sent as a response to the client (step 132)* (Column 13, line 66 – Column 14, line 13), compare with **d) includes**

selecting and transmitting data of an appendix from the reader to the server.

17. **Regarding independent claim 38**, the claim incorporates substantially similar subject matter as claim 25 and is rejected along the same rationale.

18. **Regarding dependent claim 39**, the claim incorporates substantially similar subject matter as claim 33 and is rejected along the same rationale.

19. **Regarding dependent claim 40**, the claim incorporates substantially similar subject matter as claim 25 and is rejected along the same rationale.

20. **Regarding dependent claim 41**, the claim incorporates substantially similar subject matter as claim 32 and is rejected along the same rationale.

21. **Regarding dependent claim 42**, the claim incorporates substantially similar subject matter as claim 26 and is rejected along the same rationale.

22. **Regarding dependent claim 43**, the claim incorporates substantially similar subject matter as claim 27 and is rejected along the same rationale.

23. Claims 28 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) and Sastry et al. (US 6687877 B1) as applied to claims 25 – 27 and 32 – 43 above, and further in view of Mandri (US 6549751 B1).

24. **Regarding dependent claims 28 – 30**, Mandri teaches that *the student workstations 8 connect to the data storage device 4 through an access control device 6. Each student workstation has a unique access code. When a student wants to download a book from the data storage device 4, the student submits a unique code, specific to the workstation or e-book device. This access code is compared with a stored key and the download is only permitted when there is a match. The instructor's workstation 2 has the ability to access the books stored on the data storage device 4 and to annotate them with hyperlinks to supplementary information* (Column 3, lines 53 – 63), compare with **a) includes transmitting a software program for an e-book to the reader, a) includes transmitting a software program for an e-book to the reader and saving the software program on a memory of the reader, and a) includes transmitting a software program for computer assisted instruction to the reader**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Mandri with that of Eintracht et al. because such a

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combination would allow the users of Eintracht et al. the benefit of *a system and method for providing students with a portable electronic textbook which can be connected to network systems* (Column 2, lines 48 – 50).

25. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (US 6687878 B1) and Sastry et al. (US 6687877 B1) as applied to claims 25 – 27 and 32 – 43 above, and further in view of Mogul et al. (US 6243761 B1).

26. **Regarding dependent claim 31**, Mogul et al. do teach that *the clients 120 can be any type of computer, personal computers, workstations, and portable devices, such as a laptop or personal digital assistant (PDA), and the like* (Column 5, lines 18 – 20), compare with **a) having one of an electronic dictionary and a personal digital assistant**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Mogul et al. with that of Eintracht et al. because such a combination would allow the users of Eintracht et al. the benefit of *a computer implemented method for automatically adjusting the content of Web pages stored by a server computer connected to a client computer by a network path depending on the effective bandwidth on the network path* (Column 4, lines 1 – 5).

Response to Arguments

27. Applicant's arguments with respect to claims 1 – 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

NH